94 No. 94-928

FILED
JUN 19 1995
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

CONAGRA, INC. and SWIFT-ECKRICH, INC.,

Petitioners,

—v.—

OSCAR MAYER FOODS CORP.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether this Court should review the Federal Circuit's determination, in a nonprecedential opinion, that substantial evidence supported a jury's verdict that patents were not proven invalid on the ground of obviousness.

PARTIES TO THE PROCEEDINGS

The parties to this proceeding are set out in the caption.

Pursuant to Supreme Court Rule 29.1, respondent Oscar Mayer Foods Corporation has no subsidiaries. The following are parent companies of respondent:

Philip Morris Companies, Inc.

Kraft Foods, Inc.

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STATEMENT OF THE CASE

ConAgra's[1] statement of the case omits or mischaracterizes key facts regarding the background and origin of the invention that is the subject of the two patents in suit, the content of the prior art as found by the lower courts, the proceedings in the district court relating to the jury instructions, and other pertinent facts. Oscar Mayer[2] provides this responsive statement of the case in accordance with Supreme Court Rule 15.1.

A. The Background And Origin Of The Oscar Mayer Inventions

In about 1980, Oscar Mayer entered the processed poultry business by acquiring the Louis Rich Company, which sold cooked, anaerobically packaged[3] poultry products such as breast of turkey and turkey cold cuts. Until that time, Oscar Mayer's product line consisted almost entirely of cured red meats, such as hot dogs, bologna and ham. "Cured" meat contains sodium nitrite, which was known to be an effective inhibitor of the growth of some types of bacteria, among them *Clostridium botulinum* ("*C. bot.*"). But, despite its inhibitory property, nitrite could not be used in all poultry products because it produces a pink color.

C. bot. is the bacteria that causes botulism, an often fatal form of food poisoning. *C. bot.* has two states: a dormant state in which the organism exists in the form of a spore; and a vegetative state in which the organism grows and, most pertinent, produces the toxin that causes botulism when ingested.

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[1] Unless otherwise noted, petitioners ConAgra, Inc. and Swift-Eckrich, Inc. are collectively referred to throughout as "ConAgra."

[2] Respondent Oscar Mayer Foods Corporation is referred to throughout as "Oscar Mayer."

[3] An anaerobic package is substantially devoid of oxygen. A plastic vacuum package is an example.

The toxin produced by *C. bot.* is the most poisonous substance known to man.

Several conditions must coincide for *C. bot.* toxin to be present in food at the time of consumption: (1) the food must be in an anaerobic environment such as in a vacuum package (because *C. bot.* is a strict anaerobe, it can only grow in the absence of oxygen); (2) the food must not be too acidic, *i.e.*, the pH of the food must be above 4.6; (3) the moisture content of the food must be sufficiently high; (4) the food must not contain nitrite or sodium chloride at inhibitory levels; (5) the food must be held at a sufficient temperature for a sufficient time to allow the spores to germinate into vegetative cells and grow; and (6) the food must not be cooked immediately before consumption.[4]

The Louis Rich acquisition brought into the Oscar Mayer product line cooked, uncured, anaerobically packaged poultry products that met conditions 1-4 and 6. In 1980, Oscar Mayer inventor John Cerveny reported his concern about the potential for *C. bot.* growth in these poultry products if left unrefrigerated in distribution or in the home, *i.e.*, if condition 5 occurred.

No suitable *C. bot.* inhibiting additives for cooked, uncured, anaerobically packaged poultry were available at that time. But that was not because the industry had not tried to find any. Beginning in the mid-1970's the industry undertook an extensive effort to find an alternative *C. bot.* inhibitor to nitrite. The industry was concerned that the use of nitrite would be banned because evidence had linked nitrosamines (compounds formed from the reaction of nitrite with certain amino acids) with cancer. The effort to find a nitrite alternative included a study from 1980 to 1982 by a committee of experts appointed by the National Academy of Sciences. In

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[4] The heat of cooking will destroy the toxin if it is present. Thus, fresh, raw poultry carries no risk because it is cooked by the consumer. Pre-cooked poultry (like the packaged turkey cold cuts at issue) carries a risk because it is not cooked by the consumer.

that study, the committee specifically noted that perishable poultry products were particularly susceptible to *C. bot.* growth. Despite the extensive effort to find a suitable alternative inhibitor to nitrite, no commercially viable alternative was found.

Mr. Cerveny's concern about the risk of *C. bot.* growth in cooked, uncured, anaerobically packaged poultry was shared by ConAgra's chief microbiologist, who was a consultant to the National Academy of Sciences committee that investigated alternatives to sodium nitrite, and who had done extensive research himself toward that same goal in the 1970's.

In 1985, Mr. Cerveny and his co-workers solved the problem of finding a suitable additive—lactate salts—that would reduce the risk of botulism in cooked, uncured, anaerobically packaged poultry products. Mr. Cerveny's interest in lactate salts was prompted by seeing an ad placed by Purac, Inc. ("Purac"), a manufacturer of lactate salts, in a trade publication in 1984. The ad claimed that sodium lactate had been shown to extend the shelf life of meats such as ham and sausage, *i.e.*, cured meats, but said nothing about inhibiting the growth of *C. bot.* Because these meat products were cured, there was no concern about *C. bot.* growth in them. Mr. Cerveny and his colleagues designed a *C. bot.* challenge test in conjunction with the Food Research Institute of the University of Wisconsin. The test showed that sodium lactate delayed *C. bot.* growth and toxin formation in cooked, anaerobically packaged turkey samples kept at 80° F, and that the delay increased with sodium lactate concentration.[5]

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[5] In 1985, the Oscar Mayer inventors also discovered that lactate salts inhibited the growth of non-pathogenic "spoilage" bacteria in cooked, uncured, anaerobically packaged poultry. Spoilage bacteria grow in and spoil refrigerated food over time. That lactate salts would extend the refrigerated shelf life of cooked, uncured anaerobically packaged poultry was previously unknown in the industry.

Oscar Mayer, in conjunction with the Food Research Institute, conducted numerous tests of the inhibitory property of lactate salts against *C. bot.* between 1985 and 1991. Researchers at the University of California at Davis conducted independent investigations of a similar nature in 1993, and confirmed both the risk of *C. bot.* growth in cooked, uncured anaerobically packaged poultry products and the effectiveness of sodium lactate in delaying *C. bot.* growth in those products.

In 1991, ConAgra researchers conducted *C. bot.* inhibition tests using sodium citrate. Sodium citrate was being investigated as an alternative to sodium lactate in order to avoid the Oscar Mayer patents. These 1991 tests reflected the continuing importance of *C. bot.* inhibition to ConAgra, as well as the importance ConAgra attached to the anti-botulinal effect of sodium lactate.

B. The Conclusions Of The Lower Courts Regarding The Content Of The Prior Art On Which ConAgra Based Its Obviousness Defense

ConAgra argues the content of the prior art anew as though the lower courts gave no consideration to this evidence in their review of the jury's verdict. In reviewing the jury's verdict, both the district court and the Federal Circuit thoroughly considered the content of the prior art on which ConAgra based its obviousness defense. Both courts concluded that the prior art upon which ConAgra relies failed to provide the motivation to make the claimed combination.

In this regard, the district court concluded that none of the references teaches that lactate salts would extend the shelf life of cooked, anaerobically packaged poultry or fish products or would be a desirable flavorant in poultry or fish products. A30-34. As the district court stated:

> In conclusion, there was ample evidence to support the determination that plaintiff's invention would not have been obvious to one ordinarily skilled in the art.

> Although it was known that sodium lactate had certain preservative properties, the extent to which sodium lactate controlled the growth of bacteria including clostridium botulinum was unexpected based upon the prior art. Accordingly, the prior art would not have motivated one of ordinary skill in the art to perform the steps in plaintiff's invention.

A33-34.

Similarly, the Federal Circuit concluded that the prior art cited by ConAgra was inadequate to establish *prima facie* obviousness, *i.e.*, that the disclosures of the references were insufficient to provide the motivation to make the claimed product or practice the claimed method for any purpose. A10.

In addition, both courts below concluded that none of the prior art references upon which ConAgra relied taught that lactate salts would inhibit the growth of *C. bot.* in cooked, anaerobically packaged poultry and fish products. A12-14, A30-31. In particular, both courts concluded that the Ueno patent, ConAgra's primary reference, teaches washing *uncooked* foods in an aqueous sterilizing agent that may include sodium lactate to kill *aerobic* food poisoning bacteria. A12-13, A33. Ueno does not even mention *C. bot.* The Federal Circuit found that

> [a]ny addition of sodium lactate to the foodstuff itself is incidental and unmentioned. ConAgra admits that the foods in Ueno are cooked before being eaten. Thus, there was not even the potential for botulism.

A12.

The lower courts found ConAgra's other references to be even less pertinent. Both courts found that the Japanese patent application of Fukui taught nothing about the use of sodium lactate in an anaerobic environment. A13, A32-33. Both courts found that the 1971 article by Angersbach says nothing about anaerobic bacteria such as *C. bot.* or about the

effects of sodium lactate in poultry or fish. A13, 32. The district court found that the teaching of the Purac petition that sodium lactate had been used to lower the water activity of meat products and increase their shelf life "was well-known to the patent examiner who granted [Oscar Mayer's] patents." A31.

ConAgra's argument that, ignoring the property of inhibiting the growth of *C. bot.*, the prior art taught the method steps and the poultry and fish foodstuff claimed in Oscar Mayer's patents is just that—an argument. ConAgra made the same argument to the lower courts, and that argument was not accepted. A petition for a writ of certiorari to this Court is not the appropriate place to reargue the content of the evidence presented at the trial.

C. ConAgra's Responsibility For The Jury Instructions About Which It Complains

In complaining about the district court's instructions to the jury (Petition 8-12), ConAgra ignores the responsibility it bore for the content of them. The district court gave a full account of ConAgra's role in its decision on ConAgra's post trial motions. A34-38. In summary, the instructions were the direct result of ConAgra's strategy of seeking to have the claims of Oscar Mayer's patents interpreted narrowly to avoid infringement and broadly to establish obviousness. Specifically, to avoid a finding that it had infringed, ConAgra contended that Oscar Mayer was required to prove that ConAgra was using sodium lactate for the purpose of delaying *C. bot.* growth in its products. On the other hand, in attempting to establish that the invention was obvious, ConAgra contended that the prior art need not teach that lactate salts would delay *C. bot.* growth.

In pursuit of its strategy, ConAgra objected to an instruction proposed by Oscar Mayer that the jury should ignore ConAgra's purpose for using sodium lactate in determining whether or not ConAgra had infringed, and the district court

sustained that objection. A36-37. Subsequently, ConAgra proposed an instruction that the purpose of delaying *C. bot.* growth should be disregarded in determining whether the claims were obvious over the prior art. The district court sustained Oscar Mayer's objection to this instruction. In its decision on ConAgra's post-trial motions, the district court observed that ConAgra could not complain about the absence in the instructions of any mention of "purpose" having first objected to Oscar Mayer's proposed instruction. A38.

In any event, the Federal Circuit correctly held that ConAgra's proposed instruction regarding "purpose" would have been misleading because "[t]he problem the inventors in their application claim to have solved is relevant to the obviousness inquiry." A11.

SUMMARY OF ARGUMENT

1. ConAgra does not challenge the constitutionality of 35 U.S.C. § 103, the statute under which this case was decided, but rather the rulings of the lower courts that substantial evidence supported the jury's verdict that the patents were not proven invalid for obviousness. The Federal Circuit properly recognized the interrelationship between the problem to be solved by the inventor and the factual inquiries upon which a determination of obviousness must be based. The courts below concluded that the prior art cited by ConAgra neither taught nor suggested making the product or practicing the method claimed in the Oscar Mayer patents for any purpose. Therefore, the patents did not withdraw knowledge from the public domain; that knowledge was not there in the first place.

2. There is no important question of federal law at issue that has not been decided by this Court. Both this Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), and the Federal Circuit in the instant case recognized the relevance of the

problem to be solved in determining the scope and content of the pertinent prior art. Both lower courts followed the standard analysis mandated by *Graham* in reviewing the jury's verdict that the patents had not been proven obvious.

3. The decision below did not conflict with any decision of this Court. The cases cited by ConAgra were inapposite, either because they related to a section of the patent statute not at issue here (*Knapp v. Morss*, 150 U.S. 221 (1893)), or because the decision below was in conformity with this Court's analysis (*General Electric Co. v. Jewel Incandescent Lamp Co.*, 326 U.S. 242 (1945)).

ARGUMENT

I. INTRODUCTION

This case involves none of the considerations that prompt this Court to undertake review on a writ of certiorari. The nonprecedential opinion below involves no constitutional question, presents no important question of federal law that has not been settled by this Court, and does not decide a federal question in a way that conflicts with any applicable decision of this Court or that of any other United States court of appeals.[6] Supreme Court Rule 10.1. This case presents a routine instance of the Federal Circuit reviewing a judgment based on a jury verdict that patents had not been proven invalid on the ground of obviousness, and determining that the verdict was supported by substantial evidence.

The questions ConAgra presents for review by this Court presume what the jury and the lower courts concluded that ConAgra failed to prove, namely, that the Oscar Mayer patents withdrew from the public domain a composition and a method that were obvious to one of ordinary skill in the art.

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[6] The question of conflict with another United States court of appeals is inapposite here since the Federal Circuit has exclusive jurisdiction over appeals from the district courts in patent infringement cases.

The district court determined that the findings of the jury implicit in their rejection of ConAgra's obviousness position were supported by substantial evidence. The Federal Circuit reviewed and affirmed this determination. Although attempting to frame the questions in "certworthy" terms, ConAgra is in fact inviting this Court to review the evidence presented at the trial and make its own determination as to whether the jury's verdict was supported by substantial evidence. The Court has stated that it does not "grant a certiorari to review evidence and discuss specific facts," *United States v. Johnston*, 268 U.S. 220, 227 (1925), much less findings of fact "in which two courts below have concurred." *United States v. Doe*, 465 U.S. 605, 614 (1984). There is no reason for the Court to make an exception in this case.

II. THIS CASE RAISES NO CONSTITUTIONAL ISSUE

To persuade this Court to review this case, ConAgra tries to turn the routine application of a statutory standard into a constitutional issue. It does not work.

Article I, § 8 of the Constitution grants Congress the power "To promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries." Congress exercised that power beginning in 1790 with the enactment of the first Patent Act. In 1952, Congress rewrote the patent laws and added 35 U.S.C. § 103 to codify existing judicial precedent that more than novelty and utility were required to render an invention patentable. Section 103 sets forth the "non-obviousness" standard for measuring the patentability of inventions.

ConAgra challenged the validity of the Oscar Mayer patents in this case under the standard of § 103, and the lower courts ruled that ConAgra had failed to prove that the patents did not meet that standard. ConAgra does not contend in its petition, nor did it contend below, that § 103 itself is incon-

sistent with the constitutional standard Congress must meet in exercising its power to authorize the issuance of patents, namely, that the invention must "promote the Progress of Science and useful Arts." ConAgra merely disagrees with the rulings of the lower courts that, on the evidence presented at trial by ConAgra, the jury could properly conclude that the claims of the Oscar Mayer patents met the non-obviousness standard of § 103. This is an issue of the application of a statute, the constitutionality of which is unchallenged, to the specific facts of a specific case. The issue is whether the lower courts correctly applied the statute to the facts in upholding the jury's verdict, not whether the Constitution was violated.

In its effort to frame a constitutional issue, ConAgra states that the Court of Appeals failed to recognize and apply the constitutional "standard" of patentability, thereby withdrawing previously known information from the public domain. In this regard, ConAgra criticizes the Federal Circuit because it distinguished between the concerns involved in determining patentability based on novelty and on nonobviousness. However, it is long-established that the factual inquiries involved in these separate determinations differ. For a patent claim to be held invalid for lack of novelty based on the prior art, the factual inquiry is whether each and every element of the claim is found in a single prior art reference. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1034 (1987). In contrast, for a patent claim to be held invalid based on obviousness, four factual inquiries, delineated in *Graham*, 383 U.S. at 17-18, must be resolved: the scope and content of the prior art; the level of skill of the ordinarily skilled practitioner of the art; the differences between the prior art and the claimed invention; and whether there are any secondary considerations present, such as a long felt need for a solution to a problem, that might assist the court in avoiding hindsight in reaching its legal conclusion. In addressing ConAgra's argument that

the "purpose" of the inventor must be held irrelevant to the obviousness inquiry, the Court of Appeals correctly points out that the problem to be solved is inextricably interwoven with the factual inquiries required by *Graham v. John Deere*. A10-11.

ConAgra bootstraps its distortion of the Federal Circuit's opinion into an argument that, contrary to precedent, the Federal Circuit's decision permits the subtraction of available resources from the public. The authority it cites for this proposition is inapposite. *See Great A&P Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152 (1950); *Anderson's-Black Rock v. Pavement Salvage Co.*, 396 U.S. 57, 60-61 (1969). In those cases, the Court held that the claimed invention was merely a collection of old mechanical elements, performing their same and expected functions in combination that they previously performed separately. Here, in contrast, the lower courts held that there was substantial evidence to support the jury's implied conclusion that the claimed product and method were nonobvious—*i.e.*, that the prior art neither taught nor suggested making the claimed product or practicing the claimed method for any purpose. Thus, no knowledge was withdrawn from the public; the public was not in possession of the claimed product or method until the Oscar Mayer inventors disclosed it.

Notably, ConAgra made no constitutional argument in its appeal of the judgment of the district court to the Federal Circuit. No doubt ConAgra hopes that "Constitution" is the magic word that gains entry to this Court. But there is no substance to ConAgra's argument; there is no constitutional issue here.

III. THIS CASE RAISES NO IMPORTANT QUESTION OF FEDERAL LAW THAT HAS NOT BEEN DECIDED BY THIS COURT

Moreover, this case raises no important question of federal law that this Court has not decided. Conspicuously absent from ConAgra's petition is any citation to *Graham*, this Court's seminal case on the analytical approach, discussed above, that courts must take in applying § 103.

In applying the required analytical approach to the facts before it in *Graham*, the Court recognized the relevance of the problem that the inventor addressed to the determination of what constitutes pertinent prior art:

> Cook Chemical argues, however, that Livingstone is not in the *pertinent* prior art because it relates to liquid containers having pouring spouts rather than pump sprayers. . . . *The problems confronting Scoggin and the insecticide industry were not insecticide problems; they were mechanical closure problems.* Closure devices in such a closely related art as pouring spouts for liquid containers are at the very least pertinent references.

383 U.S. at 35 (second emphasis added) (citations omitted).

The district court and Federal Circuit both followed the analysis mandated by *Graham* in reviewing the jury's verdict that the Oscar Mayer patents had not been proven obvious. In its opinion, the Federal Circuit, like this Court in *Graham*, recognized the relevance of the problem the inventor confronted to the determination of the pertinent prior art, and correctly perceived its implications for the entire obviousness analysis:

> *Because the problem affects the definition of the prior art, it therefore affects each of the first three Graham factors: the prior art's scope and content, the art's level*

> *of ordinary skill, and the prior art's differences from the claimed invention.*

A11 (emphasis added) (citations omitted).

The Federal Circuit's use of the problem addressed by the Oscar Mayer patents to frame its application of the *Graham* analysis to the facts of this case was consistent with the approach the Court took to the facts before it in *Graham*. In *Graham*, the Court looked to see what the prior art taught about the problem of capping a pump sprayer head. The Court found that the prior art taught Scoggin's solution to the mechanical closure problem he confronted. In its opinion in the instant case, the Federal Circuit looked to see what the prior art taught about the problem of *C. bot.* in cooked, anaerobically packaged poultry and fish products. The Federal Circuit agreed with the district court and the jury that the prior art did not teach the inventors' solution to the problem of *C. bot.* in these products. The Federal Circuit's opinion broke no ground on the interpretation or application of § 103 that this Court had not already broken in *Graham*.

IV. THE DECISION BELOW IS NOT IN CONFLICT WITH ANY DECISION OF THIS COURT

ConAgra's argues that the decisions below are in conflict with this Court's decisions in *Knapp v. Morss* and *General Electric Co. v. Jewel Incandescent Lamp Co.* ConAgra's unfounded argument is predicated on its characterizations of the Oscar Mayer invention and the prior art in the Petition in a manner calculated to make this case appear factually similar to *Knapp* and *General Electric*. It is not even close.

ConAgra characterizes the invention as "the addition of lactate salts to [sic: poultry] or fish food products" (Petition 2), and argues that adding lactate salts to poultry or fish products would have been obvious. ConAgra ignores the limitations on the products and the method of making them set forth in the claims, *i.e.*, that the products are cooked at high humidity, but

not sterilized, and are packaged in anaerobic plastic barrier packages. A3-4. These limitations are central to the problem addressed by the Oscar Mayer patents. *C. bot.* requires a moist environment in which to grow. It is an anaerobic organism; it does not grow in the presence of oxygen. The toxin it produces is easily destroyed by heat, and thus if the food is cooked immediately before it is consumed the risk of botulism will be eliminated. A2-3. Thus, it is only in moist, pre-cooked, anaerobically packaged food, such as packaged turkey cold cuts, that the risk of botulism arises. The use of lactate salts in other food contexts, as disclosed in the prior art on which ConAgra relied, taught nothing about the utility of lactate salts as a *C. bot.* inhibitor.

Moreover, the district court found that the prior art did not teach *any* utility of lactate salts in cooked, anaerobically packaged poultry or fish.

> The Court finds that there was substantial evidence at trial to support the finding that the prior art did not teach that sodium lactate would be useful under the circumstances of plaintiff's patent claims. The evidence suggested three possible motivations to use sodium lactate in the plaintiff's patented process: (1) for the control of clostridium botulinum, (2) as a flavorant, and (3) as a shelf life extender. The evidence at trial was very strong that the property of retarding the growth of clostridium botulinum was unknown in the prior art. Similarly, there is little suggestion in the prior art that sodium lactate is a desirable flavorant in poultry or fish.
>
> . . .
>
> Although it was known that sodium lactate had certain preservative properties, the extent to which sodium lactate controlled the growth of bacteria including clostridium botulinum was unexpected based upon the prior art.

A30-31, A33-34.

By concluding that there was no showing of *prima facie* obviousness under *In re Dillon*, 919 F.2d 688 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991), the Federal Circuit confirmed the holding of the District Court that the prior art—even without consideration of the effect on *C. bot.* discovered by the Oscar Mayer inventor—did not provide the motivation to make the claimed combination. A10. In *Dillon*, the Federal Circuit held that the claimed invention was unpatentable because the prior art provided the motivation to combine the teachings of the cited references to make the claimed composition, albeit for a different use than that contemplated by the inventor. In this regard, the court stated that "structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness . . . ." *Id.* at 692. The court noted that "the discovery that a claimed composition possesses a property not disclosed for the prior art subject matter, does not by itself defeat a *prima facie* case." *Id.* at 693.

In view of the conclusions of the lower courts in this case, ConAgra's reliance on *General Electric Co.* is misplaced. In that case, the Court held that the prior art showed etching the inside of a light bulb, and also showed the benefit of the claimed circular crevices, provided by a second etching, in creating a light bulb that diffuses light without a substantial loss of efficiency. 326 U.S. at 248. However, the art did not disclose the strengthening effect of the crevices claimed by the inventor in that case. *Id.*

In *General Electric*, the prior art provided a motivation to combine the teachings of the prior art references to achieve the benefit taught. *Id.* In the instant case, the prior art disclosed no obvious benefit to be gained from including a lactate salt in cooked, but not sterilized, anaerobically sealed chicken or fish. The Federal Circuit so found, consistent with the district court, as evidenced by its statement that the prior

art was inadequate to establish *prima facie* obviousness under *Dillon*. A10.

Thus, far from withdrawing knowledge from the public domain, Oscar Mayer has made an important and patentable contribution to public knowledge. The analysis of the Federal Circuit in this case, as in *Dillon*, is consistent with that of the Court in *General Electric*.

The Federal Circuit's opinion in this case is also not at all inconsistent with the Court's decision in *Knapp*. Contrary to ConAgra's assertions, *Knapp* is a case involving the novelty of the claimed invention—*i.e.*, whether the disclosure of a single prior art reference contained all the elements of the claimed invention. In this regard, the Court explicitly states:

> But, aside from these prior patents, the state of the art is perhaps more clearly illustrated in the device used for opening and shutting a common umbrella. *In this device are found all the elements of the combination of the second claim.*

150 U.S. at 226 (emphasis added).

In conformity with the Court in *Knapp*, the Federal Circuit here acknowledged that subject matter that is not novel cannot be withdrawn from the public domain merely because a new additional use is discovered. The Court in *Knapp*, however, interpreted what is now a different section of the patent law, and their holding is inapposite to the facts and issues present here.

The lower courts in this case examined the invention of the Oscar Mayer patents as recited in the claims "as a whole," in compliance with § 103. Unlike ConAgra, the lower courts did not oversimplify the invention by conveniently ignoring elements of the claims. Unlike ConAgra, the lower courts did not fill in what the prior art did not fairly teach to make it appear more pertinent than it is. Based on their thorough review of the evidence, the lower courts correctly upheld the jury's ver-

dict that the invention of the Oscar Mayer patents was not proven obvious.

CONCLUSION

None of the considerations that this Court applies to guide its acceptance of cases on petition for writ of certiorari are present here. The petition merely invites the Court to repeat what the lower courts have already done thoroughly and correctly—review the evidence to determine whether substantial evidence supports the jury's verdict on obviousness. The Court should decline the invitation to revisit this evidence for the third time.

For the foregoing reasons, the petition for writ of certiorari should be denied.

Respectfully submitted,

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